

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/392,585
Attorney Docket No. Q55716

REMARKS

Claims 1-4, 6-11, and 13 are all the claims pending in the application. The Examiner objected to claim 1 in view of 37 C.F.R. § 1.75, because the Examiner stated that the recitation “the isolated franking machine” in line 12 is not supported. Applicant has amended claim 1 in a non-narrowing manner to more clearly define “the isolated franking machine” as --the at least of the isolated franking machines-- for the Examiner’s understanding.

35 U.S.C. § 103(a) Rejections

The Examiner rejected claims 1, 4, 7-11, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Le Carpentier, U.S. Patent No. 4,752,950 in view of Kim et al. (Kim), U.S. Patent No. 5,224,046. Applicant respectfully traverses this rejection for following reasons.

First, Applicant submits that Le Carpentier actually teaches away from the present invention as indicated by the Examiner. Specifically, the Examiner states in the paragraph bridging pages 3 and 4 of the Office Action that “[a]n ordinary artisan in the art at the time the invention was made, would have been motivated to look at replacing the inconvenient and time-consuming procedures of human intervention with a more automated and less convenient system” citing Le Carpentier, col. 1, lines 45-50. As such, Applicant submits that one of ordinary skill in the art would not have been motivated to combine Le Carpentier (which, as well established by the Examiner does not show at least one of the franking machines being

electrically isolated from the public communications network, e.g., see page 3 of the current Office Action) with Kim. The present invention is contrary to the Examiner's admission and the teachings of Le Carpentier due, in part, to the large number of traditional electromechanical franking machines that cannot be electrically connected (e.g., 100,000 in France alone as stated on page 2 of the present specification). Accordingly, Applicant submits that the rejection of these claims is improper.

Applicant respectfully submits that a second reason the rejection of these claims is improper is because of impermissible hindsight. That is, because the Examiner himself acknowledges that Le Carpentier teaches away from the present invention, it is apparent that the Examiner is using impermissible hindsight in the rejection. Assuming *arguendo* that the meter of Kim is electronically isolated at some point in time, as alleged by the Examiner, the entire disclosure of Kim nonetheless teaches a system in which the meters are normally expected to be connected to a network and are shown in the drawings as connected to a network (see Fig. 2). In fact, the meters are configured to be reset by the system 10a (see col. 5, line 13). As such, like the Examiner's statement regarding Le Carpentier, one of ordinary skill in the art at the time of invention would understand Kim, taken as a whole, to teach use of automation and not to electrically isolate the meters. Obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). As such, it is the prior art itself, and not the Applicant's disclosure, that must establish the obviousness of the combination. Accordingly, because there is no suggestion in the prior art (because the Examiner acknowledges that Le Carpentier teaches away from the present

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invention (as does Kim as a whole)), it is apparent that the Examiner is using Applicant's own achievement for the motivation rather than the prior art. Therefore, the rejection of the claims is also improper for this reason.

Third, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In the rejection of claim 1, on page 3, the Examiner does not directly address the feature "via at least one supervision terminal from which the plurality of franking machines *is independent*". In fact, the Examiner leaves the "is independent" feature of the claim out of his recitation of the claim in this rejection on page 3. Perhaps this is because on page 8 of the Office Action, the Examiner states, when addressing Applicant's arguments filed on March 6, 2003 (February 28, 2003 for the record), that "[a]s to 'Point A', it is the Examiner's position that the features upon which the Examiner relies (i.e., all of the plurality of franking machines are independent from the supervision terminal) are not recited in the rejected claim(s)." The Examiner goes on to explain the case law behind his comment, in summary, that limitations from the specification are not read into the claims. As shown in claim 1, this "independent" feature is recited, contrary to the Examiner's assertions. In addition, a full reading of Applicant's paragraph from the February 28, 2003 submission appears to be very clear on this point. Further, the Examiner himself provides as the reason for requiring further search and consideration in the March 28, 2003 Advisory Action that "[t]he issue of plurality of franking machines is independent changes the

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scope of the claims as originally presented.” Therefore, the Examiner’s Response to Arguments on page 8 of the Office Action is incorrect and contradictory to his own earlier statements.

Moreover, the Examiner does not even address the “independent” feature when he further states that Le-Carpentier-Kim does teach a plurality of [sic] franking machines (i.e. meters) that are separate from the local stations.” In this statement, the Examiner improperly interchanges the recited term “independent” with his own term “separate”. These two terms can have different meanings and should not necessarily be interpreted as interchangeable. As a result of this, Applicant submits that the Examiner has not properly addressed how the “independent” feature is shown by the prior art. Applicant respectfully refers the Examiner to the February 28, 2003 Amendment (the remarks incorporated herein by reference) for the reasons why the “independent” feature of the present invention is different than what is disclosed by Le-Carpentier or Kim.

The Examiner’s hindsight can also be recognized, for example, in the rejection of claim 8 which recites that “the code of authorization to frank is obtained by calculation from one of the current invoicing index and a serial number of a printing head.” The Examiner cites that the “authorization to frank” feature is taught by Kim while the “serial number of a printing head” is disclosed by Le Carpentier.

First, Applicant respectfully submits that the Examiner has not provided any reason why one of ordinary skill in the art would have been motivated to combine these two references to obtain the recited feature. Merely because individual features may be found in the references

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does not provide the motivation to combine the references citing these features to obtain the recited feature. Nor does this individual disclosure in separate references provide a reason why the claimed feature is obvious.

Accordingly, Applicant submits that these claims are allowable for the many reasons provided above.

The Examiner rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Le Carpentier and Kim as applied to claims 1, 4, 7-11, and 13 above, and further in view of Gerszberg et al. (Gerszberg), U.S. Patent No. 6,359,881. The Examiner also rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Le Carpentier and Kim as applied to claims 1, 4, 7-11, and 13 above and further in view of Breault et al. (Breault), U.S. Patent No. 4,908,770. At least for the reasons above and because claims 2 and 3 are dependent on claim 1, Applicant submits that these claims are allowable. The addition of Gerszberg does not remedy the lack of teaching of Le Carpentier and Kim. Likewise for dependent claim 6 and the disclosure of Breault.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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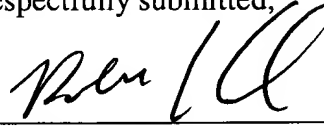
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